

The opinion in support of the decision being entered today was **not** written for publication and  
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* ROLAND DE LA METTRIE, JEAN COTTERET,  
ARNAUD DE LABBEY, and MIREILLE MAUBRU

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U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2005-1655  
Application No. 09/852,624

HEARD: September 15, 2005

Before GARRIS, WARREN, and TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

***DECISION ON APPEAL***

This appeal involves claims 30-46. Claims 47-53, the only other claims pending in the application, stand withdrawn from consideration (Brief, p. 3). We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

### ***INTRODUCTION***

The claimed subject matter relates to a cosmetic composition intended for treating keratin fibers, i.e., hair. Claim 30 is illustrative:

30. A ready-to-use composition for the oxidation dyeing of keratin fibers, comprising:

- (a) at least one enzyme chosen from 2-electron oxidoreductases,
- (b) at least one donor for said at least one enzyme,
- (c) at least one anionic surfactant chosen from:
  - (i) acylsethionates;
  - (ii) acyltaurates;
  - (iii) acylsarcosinates;
  - (iv) acylglutamates;
  - (v) polyoxyalkylenated carboxylic ether acids and salts thereof;
  - (vi) fatty glucamide sulphates;
  - (vii) alkylgalactoside uronates; and
  - (viii) anionic derivatives of alkylpolyglucoside; and
- (d) at least one oxidation base.

The claims are rejected under 35 U.S.C. § 103(a). As evidence of unpatentability, the Examiner relies upon the following prior art references:

Tomura et al. (Tomura)	6,027,719	Feb. 22, 2000
Lim et al. (Lim)	6,045,590	Apr. 4, 2000

Specifically, claims 30-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tomura in view of Lim.

We affirm substantially for the reasons advanced by the Examiner and we add the following primarily for emphasis.

***OPINION***

As Appellants argue the claims as a group, we select a single claim to decide the appeal in accordance with 37 CFR § 41.37(c)(1)(vii)(2004). We select claim 30. Claim 30 is directed to a composition for the oxidation dying of keratin fibers. The composition must contain, at least, (a) an enzyme from 2-electron oxidoreductases, (b) a donor, (c) an anionic surfactant, and (d) an oxidation base.

The Examiner finds, and Appellants do not dispute, that Tomura describes a composition having the required enzyme, donor, and oxidation base in accordance with components (a), (b), and (d) of claim 30. The question is whether it would have been obvious to one of ordinary skill in the art of hair dying to incorporate one of the listed anionic surfactants of component (c) into the composition of Tomura. Because Tomura specifically suggests the inclusion of anionic surfactants and Lim indicates that at least some of the anionic surfactants of component (c) of claim 30, namely, acylsarcosinates and acylsethionates, were known for use in hair dying compositions, we agree with the Examiner that it would have been obvious to one of ordinary skill in the art to select one of those known surfactants as the anionic surfactant of Tomura to provide the properties expected from an anionic surfactant in the hair dying composition of Tomura.

Appellants argue that “there is no evidence of a reasonable expectation of success in combining Tomura and Lim and, further, there is no motivation to combine the references even if

there was a reasonable expectation of success." (Brief, p. 10). We disagree for the following reasons.

These arguments are based on the alleged unpredictability of adding additional ingredients to the polymer-alkali-uric acid system of Tomura. Specifically, according to Appellants, the addition of further ingredients would unpredictably affect uric acid solubilization. Appellants' arguments are not supported by the evidence. Namely, there is no convincing evidence that those of ordinary skill in the art would have understood acylsarcosinate and acylisethionate anionic surfactants, the surfactants taught by Lim as typically used in hair dyes, as having an adverse affect on the solubility of uric acid in the system of Tomura. In fact, Tomura indicates that, in addition to solubilization of the uric acid, in practice, it is necessary to add surfactants and polymers to make the composition fit for use on hair and skin (col. 1, ll. 44-50).<sup>1</sup> Tomura is directed to providing a technique for stably solubilizing uric acid in an aqueous cosmetic composition containing uric acid and a water-soluble polymer (col. 1, ll. 56-58). According to Tomura, it is the selection of the polymer in the uric acid and alkali system that is critical (col. 2, ll. 2-29). Tomura further indicates that "other ingredients are added to obtain the desired aqueous cosmetic compositions in various preparation forms such as gel, paste, cream

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<sup>1</sup>We disagree with Appellants' interpretation of column 1, lines 50-53 of Tomura as teaching that some surfactants are not satisfactory in solubilizing uric acid (Brief, p. 11). That paragraph is referring to the prior art and must be read in context with the rest of the disclosure. There is no particular emphasis on surfactants as having an adverse affect on solubility in the disclosure of Tomura. In fact, column 1, lines 45-59 indicate that the addition of surfactants is necessary to make the composition useful for hair and skin application.

and the like (col. 3, ll. 35-40). Tomura specifically mentions anionic surfactants in a list of additives for use in the composition “according to the desired preparation form.” (col. 3, ll. 42-52). While Tomura modifies the list of additives with the words “can be appropriately added in so far as they do not adversely affect the present invention” we cannot agree with Appellants that this broad brush language negates the suggestion that additives such an anionic surfactants be added. Tomura specifically indicates that such additives are necessary to make the composition useful (col. 1, ll. 48-49; col. 3, ll. 35-52).

Appellants argue that experimentation disclosed in Tomura on the effects of alkali and water-soluble polymers on the stability of solubilized uric acid shows that a large amount of experimentation is required to find solution conditions such that uric acid solubilization is stabilized when these ingredients are added and that no such experimentation on surfactants of any type has been evidenced by the Examiner (Brief, p. 14). First, Tomura provides guidance on how to select and add alkali and water-soluble polymer to obtain the required solubilized uric acid stability. Tomura further suggests the addition of other additives including anionic surfactants and further exemplifies compositions including additives including an example of a one-package hair dye (Example 1). With respect to surfactant selection, there is no sufficient evidence of record indicating that an amount of experimentation over and above what would be routine in the art would have been required. In fact, the general discussion in Tomura of using anionic surfactants with no further guidance provides evidence that selection of the appropriate surfactant was recognized as within the skill of the art.

Nor can we agree with Appellants that the surfactants of Lim would have been merely “obvious to try” in the composition of Tomura. An invention is “obvious to try” where the prior art provides either no indication of which parameters would be critical or no direction as to which of many possible choices is likely to be successful. *Merck & Co. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1845 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989)(quoting *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988)). Here, the indication is that the selection of anionic surfactant is not particularly critical, it is the alkali and polymer combination which is critical for stable solubilization of uric acid. There is no indication that anything more than routine experimentation is required to select the anionic surfactant that will be useful in the composition of Tomura.

Nor can we agree that the Examiner has failed to provide specific reasoning for combining the teachings of Lim with those of Tomura (Brief, p. 17). Tomura directs one of ordinary skill in the art to select anionic surfactants for use in the hair dye composition discussed therein and Lim provides evidence of what anionic surfactants were known in the art for use in hair dyes. That one of ordinary skill in the art would have selected those typical anionic surfactants for their known properties flows from the disclosures in Tomura and Lim.

We conclude that Tomura’s suggestion that anionic surfactants can be appropriately added to the compositions of Tomura without any specific evidence that certain anionic surfactants would have been known to adversely affect uric acid solubility coupled with the fact that acylsarcosinates and acylsethionates were typically used in hair dye compositions, as

surfactants would have been known to adversely affect uric acid solubility coupled with the fact that acylsarcosinates and acylsethionates were typically used in hair dye compositions, as evidenced by Lim, provides the requisite evidence of both a motivation to combine and a reasonable expectation of success to support a *prima facie* case of obviousness.

As a final point, we note that Appellants base no arguments upon objective evidence of non-obviousness such as unexpected results. We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 30-46 which has not been sufficiently rebutted by Appellants.

### ***CONCLUSION***

To summarize, the decision of the Examiner to reject claims 30-46 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

CT/jrg

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